

REMARKS

Applicants acknowledge receipt of the office action dated November 9, 2007, in which the Examiner rejected claims 1-30 as indefinite under § 112, second paragraph; rejected claims 1-30 as indefinite under § 112, first paragraph; rejected claims 1, 7, 13, 15, 19, 21-22, 24-26, 28 and 30 as obvious in view of Garwood and Ishida; rejected claims 2-3, 8-9, 14, 23, and 29 as obvious in view of Garwood, Ishida, and Richardson; rejected claims 1, 4, 13, 16, 22, 25, and 27 as obvious in view of Ishida and Chevron; rejected claims 5-6, 17-18, and 20 as obvious in view of Chevron and Richardson; and rejected claims 11-12 as obvious in view of Chevron, Richardson, and O'Rear.

Applicants thank the Examiner for the thoroughness of the examination and detailed arguments set out in the office action. Nonetheless, Applicants respectfully traverse all of the rejections for the reasons set out below.

Rejection of claims 1-30 as indefinite under § 112, first and second paragraphs

Claims 1-30 have been amended to claim compositions again, rather than methods.

Rejection of claims 1, 7, 13, 15, 19, 21-22, 24-26, 28 and 30 as obvious in view of Garwood and Ishida

Claims 1 has been amended to recite that the lubricating oil composition includes a lubricating oil base oil and a primary amine having a tertiary alkyl group. None of the cited documents, including in particular Garwood and Richardson, discloses the combination of features as recited in claim 1. Therefore, claim 1 as amended is novel. The other pending claims depend from claim 1 and are therefore also novel.

The Examiner considers Garwood to be the closest prior art. Garwood relates to a process for producing a high VI, low pour point lubricant from a petroleum feed. Garwood does not mention the problem of energy conservation in hydraulic systems. Further, Garwood does not mention lubricating oil compositions having a density in the range as specified in claim 1 (which will be in the order of at least 10% higher at the same viscosity).

As is explained in the "Overview of results" on page 34 and 35 of the present description, the present invention includes the discovery that—by making use of lubricating oil compositions containing a specific amine and a specific narrow-cut base oil—it is possible to increase energy conservation to a surprising degree. The lubricating oil compositions according to the present invention have a density that is about 10% less than that of commercial lubricating oils of the same viscosity. As explained in page 1 of the description, energy conservation in hydraulic

systems is highly desired. The present invention provides such energy conservation. The lubricating oil compositions according to the present invention also show a desirable storage stability.

Claim 1 of the present invention differs from Garwood in the presence of a specific amine. The Examiner refers to Richardson for teachings of a primary amine having a tertiary alkyl group. Richardson relates to compositions for extending seal life and is in no way related to solving the problem of energy conservation in hydraulic systems. Thus, a person skilled in the art, when confronted with the problem of energy conservation would not look to Richardson for a solution. Furthermore, even if the person skilled in the art did consider Richardson, he or she would still not arrive at the invention, as there is no teaching in Garwood or Richardson to use a lubricating oil composition having the specific density (at the given viscosity) as required according to claim 1 of the present invention.

For all of these reasons, it is respectfully submitted that claim 1 of the present application is both novel and inventive over Garwood and Richardson.

As the balance of the rejections are based on the combination of Richardson with other references, Applicants respectfully request that the Examiner reconsider and withdraw all of the rejections based on prior art and allow the claims.

Conclusion

In view of the foregoing, Applicants believe that all of the claims are in condition for allowance and favorable consideration by the Examiner is requested. Should the Examiner find any impediment to the prompt allowance of the claims that can be corrected by telephone interview, the Examiner is requested to initiate such an interview with the undersigned.

Respectfully submitted,
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